**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE PATENT APPLICATION OF: CONFIRMATION NO. 2757

VARGHESE, Kivin DOCKET: VAR-3

APPLICATION NO.: 10/605,758 EXAMINER: NGUYEN, V.

FILING DATE: October 23, 2003 ART UNIT: 2151

TITLE: An Internet System for the Uploading, Viewing and Rating of Videos

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP AF
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the guidelines set forth in 1296 *O.G.* 67 and 1303 *O.G.* 21, Applicant respectfully requests a pre-appeal brief panel review of the final rejection. No amendments are being filed with this request. This request is being filed concurrently with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

**Certificate of Filing by EFS**

The undersigned hereby certifies that this document and its listed enclosures were filed electronically in the U.S. Patent and Trademark Office using the Office's Electronic Filing System (EFS) on December 12, 2007.

/Andrew McAleavey, Reg. No. 50,535/

**REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW OF THE REJECTION**

In requesting a pre-appeal brief review of the final rejection, Applicant stands by the remarks and arguments made in the responses of record. The following are certain specific points on which Applicant would appreciate the panel's scrutiny. Whenever possible, Applicant has highlighted the place in the record where the relevant arguments were originally advanced or the evidence originally presented. Where arguments or evidence have been previously presented, the entire text of that which was previously presented should be considered to be incorporated by reference herein.

1. The Combination of Murphy and Meyers is Improper[1]

The Examiner admits that Murphy (U.S. Patent No. 6,564,380) fails to disclose collecting ratings from users, and turns to Meyers (U.S. Patent No. 7,031,931) to disclose that feature. Meyers discloses a device which can be connected to a personal media player to allow the user to rate the songs on that player. Applicant submits that Meyers is utterly irrelevant, totally unrelated to Applicant's invention and to the field of endeavor, and comes out of the proverbial "left field."

Furthermore, Meyers adds nothing substantive to the rejection. In the manner in which the Examiner uses it, it stands for nothing more than the proposition that a single user might customize his or her music playlist by expressing his or her preferences. The contribution of Meyers to the rejection as a whole is so slight that the Examiner may as well have taken Official Notice of the facts that he alleges.[2] If it would have been so obvious to collect user ratings – along with the other tasks recited in Applicant's claim – then the Examiner should have no trouble finding a reference, either in the patent literature or on the World Wide Web, that supports his allegations with more weight.

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[1] Applicant originally advanced this argument in the response to the final rejection filed on October 17, 2007 on page 4, fourth full paragraph, through page 5, second paragraph.

[2] If the Examiner were to do so, Applicant would disagree wholeheartedly, of course.

2. The Combination of Murphy and Bartholomew Lacks a Proper Basis[3]

The Examiner turns to Bartholomew (U.S. Patent No. 7,069,310) to disclose Applicant's claimed feature that video clips are of a limited and predetermined size prior to uploading. In attempting to articulate a reason to combine Murphy and Bartholomew, the Examiner states that "[i]t would have been obvious…to apply Bartholomew's creating and posting media files in Murphy's system in order to provide a better way to create, manage, and disseminate media files."

"Better" how? In what ways would a system resulting from the combination of Murphy and Bartholomew be better? Applicant respectfully submits that the stated reasoning is insufficient to support the rejection. Moreover, Applicant responded in the October 17, 2007 response that the combination might actually cripple the Murphy system or otherwise limit its utility, since the Murphy system is designed to handle live feeds, which are by definition of indeterminate length. Applicant respectfully submits that a Murphy system without the ability to handle live feeds is not "better."

3. The Examiner has Overlooked Secondary Considerations of Nonobviousness

In the October 17, 2007 response Applicant presented evidence of certain secondary considerations indicating nonobviousness, primarily beginning in the third full paragraph of page 6 and in several articles accompanying the response. In particular, Applicant sought first to explain the true field of endeavor to which he believes that his invention relates, and second, to present evidence that the claims reflect a solution to a longstanding problem in the industry with which other companies have struggled without viable solution. Applicant believes that this is an issue of a long-felt and unsatisfied industry need that the claimed invention fulfills.

To the extent that Applicant's evidence and comments are directed to events that occurred after the filing date of the present application, Applicant respectfully submits that the evidence has probative value, and that there is no bar to introducing evidence accumulated after the filing date of the application. Moreover, the two specific sites that Applicant has mentioned do have a clear nexus to the features of Applicant's claims –

[3] Applicant originally advanced this argument in the October 17, 2007 response on page 5, third full paragraph, through page 6, first paragraph.

they are sites employing methods for sharing video clips amongst users by uploading and downloading them, which is what Applicant is claiming.

4. Certain Other Points Raised in the Advisory Action

In the Advisory Action mailed November 6, 2007, the Examiner advises the Applicant that references cannot be argued individually when the rejection is based on a combination of references. Applicant was not doing that, and is not doing that now. Applicant's contention is that the Murphy reference is absent certain features that the Examiner believes it to disclose. Moreover, for reasons pointed out in the October 17 response in the last paragraph of page 3 and the first paragraph of page 4, the Examiner's statement in the final rejection of what the Murphy reference allegedly discloses contains an apparent contradiction in terms, which is one reason that Applicant focused on that reference and its disclosures.

Applicant's fundamental position is that Murphy is absent certain features, that the combination of Murphy with the other references is improper, and that even if the references were combined, the result would not be Applicant's claimed invention.

Applicant still disagrees with the Examiner's contention in the Advisory Action that "Murphy discloses providing a video clip listing, including a rating, to at least some users." In column 14, lines 27-46, Murphy discloses maintaining a list of video feeds "deemed likely to be very popular." This list is maintained in order to "determine which video feeds are to be multicast to all PoP servers," and Applicant can find no evidence in the reference that the list of ratings itself is distributed to users; instead, it appears that the rated feeds are what is distributed.

## CONCLUSION

For at least the reasons stated above, Applicant believes that the final rejection should be withdrawn and the claims allowed. Favorable action from the panel is earnestly solicited. Moreover, Applicant would appreciate any claim language or other suggestions that the panel may have. If a teleconference would be helpful, please feel free to contact the undersigned.

Respectfully submitted,

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